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10/659,325	09/11/2003	Aurora L. Fernandez-Decastro	DECASTRO10	3767

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EXAMINER

RAGONESE, ANDREA M

ART UNIT PAPER NUMBER

3743

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/659,325

Applicant(s)

FERNANDEZ-DECASTRO,  
AURORA L.

Examiner

Andrea M. Ragonese

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-28 is/are rejected.
- 7) ☒ Claim(s) 19-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The Request for Continued Examination (RCE) and the accompanying amendment, both filed on March 15, 2005, have been entered. Examiner acknowledges that **claims 9-18** have been canceled, and **claims 19-28** have been added. Subsequently, **claims 19-28** are under consideration.

### *Response to Arguments*

2. Applicant's arguments with respect to **claims 9-18** have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Objections*

3. **Claims 19-28** are objected to because of the following informalities. Appropriate correction is required.

In **claim 19**, the Examiner is unclear as to where the preamble ends and the body of the claim begins since the Applicant has failed to construct that claim with a proper transitional phrase, such as "comprising," "consisting essentially of" and "consisting of." Transitional phrases are a necessarily element of claim construction since they define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. See MPEP § 2111.03.

Additionally, in **claim 19**, the term "Said" should be deleted and —said— inserted therefor to put the claim in proper sentence form. Each claim should begin with a capital letter and end with a period. See MPEP § 608.01(m).

The Examiner also suggests deleting "it" in line 12 of **claim 19** and inserting — said area— therefor to properly set forth the metes and bounds of the claim limitation.

4. **Claims 20-22** and **25** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, the independent claim (**claim 19**) utilizes a Markush group, by reciting "the group consisting of..."

While a Markush group is an acceptable form of alternative expression, the use of the transitional phrase "consisting of" in a claim, followed by a dependent claim using the transitional phrase "comprising" is improper. See MPEP § 2173.05(h) and *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

The transitional phrases "comprising", "consisting essentially of" and "consisting of" define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); and *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App.

1948). However, the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. See *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948); and *Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1331-32, 70 USPQ2d 1508, 1516 (Fed. Cir. 2004).

A claim which depends from a claim which "consists of" the recited elements or steps ***cannot add an element or step***, which Applicant has done in dependent **claims 20-22 and 25** by reciting additional elements which were not originally claimed in the Markush group of **claim 19**.

Accordingly, **claims 20-22 and 25** have not been further treated on the merits since the Examiner is unable to ascertain the invention, which is being claimed.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first and second paragraphs of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 28** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No new matter may be entered in an amendment. All claimed subject matter must be adequately supported by the disclosure of the instant application as originally filed. **Claim 28** recites the limitation "the aperture or hole is

Art Unit: 3743

self-opening.” There is no adequate support for this claimed feature in the original specification. Therefore, this new matter must be canceled from the claim, or proper support provided to prove that the Applicant had possession of this invention in the ***specification as originally filed***.

Accordingly, **claim 28** has not been further treated on the merits since the Examiner is unable to ascertain the invention, which is being claimed, since an “aperture or hole” that is “self-opening” would need to have some type of internal mechanical structure for it to function without any outside forces. The original specification, including the drawings and the claims, does not offer this support.

7. **Claims 19-28** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **claim 19**, the terms “Said area” in line 12 and “the area” in line 13 render the claim vague and indefinite for failing to properly set forth the metes and bounds of the claim limitations by not providing proper antecedent basis. The Applicant first recites “an area” in line 4, but then recites that “***Said area*** [is] selected from the group consisting of...***an opening***...and...***an area***...” in lines 7-11; therefore, it is unclear in lines 12-13, which “area” is now being referred back to since multiple “areas” and an “opening” have now been claimed. This “area” is also recited in dependent **claims 20-23 and 25**.

**Claim 28** recites the limitation “the aperture or hole” in line 2. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3743

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 19-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson, II (US 4,890,609) in view of de Saint Rapt et al. (US 2,023,267).

Regarding **claim 19**, Wilson, II discloses a mask **1** covering at least the nose and mouth of a wearer, said mask **1** comprised substantially of filtering media for filtering air to the wearer (column 1, lines 17-21), as shown in Figures 1, 2 and 4;

said mask **10** having an area approximately over the mouth of the wearer that can be opened and closed at will;

said area selected from the group consisting of:

- a. an opening **11** covered by elastic or flexible material, such as sealing means **3** that "may be made of plastic...or many other materials" (column 2, lines 16-23); and

Art Unit: 3743

b. an area **11** of elastic or flexible material, such as the air-permeable material used to construct mask **1**, that is self-closing, as shown by the X-cut in Figures 4a-4b, wherein as broadly interpreted by the Examiner, the "self-closing" material is interpreted to be the flaps of material created by the X-cut since it is made of a fabric material. When the threaded portion **5** is inserted into the hole **11**, the flaps are in the "open" position. Once the threaded portion **5** is removed from hole **11**, flaps will "close" the opening on its own by the force of gravity; thus, the area that can be opened or closed at will is formed of a self-closing material over a hole or aperture **11**;

said area being constructed such that said area opens when a device **5** is inserted into the area and closes when the device **5** is removed therefrom.

Wilson, II discloses a mask **1** comprising all the limitations recited in **claim 19**, with the exception of providing mask **1** with an area over the mouth that can be opened and closed at will *without removing the mask*. However, the use of an area for a breathing mask that can be opened and closed without removing the mask was known at the time the invention was made. Specifically, de Saint Rapt et al. teaches the use of "valve to ensure imperviousness before, during, and after the introduction of a tube of which one end connects to the mouth" while maintaining "gastightness" from the environment, while the user is still wearing the mask. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the mask of Wilson, II by substituting one "area" [X-cut **11** in combination with sealing means **3** of Wilson, II] for another "area" [valve device of de Saint Rapt et al.]



Art Unit: 3743

because it is well known in the art, as taught by de Saint Rapt et al., to use a self-closing valve with a gas mask in order to maintain a sealed environment around the face of user while still allowing the user to intake or discharge fluids from the user's mouth by means of a device, such as a straw.

Regarding **claim 23**, as stated above, de Saint Rapt et al. teaches the use of "valve to ensure imperviousness before, during, and after the introduction of a tube of which one end connects to the mouth" while maintaining "gastightness" from the environment, while the user is still wearing the mask. This area that can be opened and closed at will is formed of an elastic or flexible self-closing material, such as two rubber discs **a** over a hole or aperture **b**.

Regarding **claim 24**, the mask **1** of Wilson, II further comprises attachments, such as a strap, as shown in Figures 1 and 4a, to maintain the mask **1** in place on a wearer.

Regarding **claim 26**, as broadly interpreted by the Examiner, the mask **1** of Wilson, II (as does the mask **h** of de Saint Rapt et al.) substantially covers the wearer's entire face, which constitutes a considerable portion of the wearer's head; thus, the mask **1** substantially covers the wearer's head.

Regarding **claim 27**, the mask **1** is made of a flexible material.

**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Andrea M. Ragonese** whose telephone number is **571-272-4804**. The examiner can normally be reached on Monday through Friday from 9:00 am until 5:00 pm.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMR   
June 10, 2005

  
Henry A. Bennett  
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